

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
Filing Date: July 20, 2001
Page 4

REMARKS

Claims 1 and 2 are pending in the instant application. Claims 1 and 2 have been rejected. Claim 1 has been amended and claim 2 has been canceled. No new matter is added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Rejection of Claims 1 and 2 under 35 U.S.C. § 112, second paragraph

Claims 1 and 2 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner suggests that use of the phrase "lung specific gene" is confusing since the claims refer to both polynucleotides and polypeptides. Thus, in accordance with the Examiner's suggestion, Applicants have amended claim 1 by replacing the term "gene" with --molecules--.

The Examiner suggests that claim 2 is vague and indefinite as the polypeptide of SEQ ID NO:48 is not expressed by SEQ ID NO:12. Without conceding to the correctness of the Examiner's position, but rather to expedite the prosecution, Applicants have canceled claim 2 thus mooting this rejection.

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
Filing Date: July 20, 2001
Page 5

Withdrawal of these rejections under 35 U.S.C. § 112, second paragraph, is therefore respectfully requested.

II. Rejection of Claims under 35 U.S.C. § 102(b)

The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Sigma 1990 has been maintained. Specifically, the Examiner suggests that an oligomer such as O 3003 is encompassed within the scope of the phrase "of SEQ ID NO:12".

Applicants respectfully disagree as such a claim interpretation does not correlate with the teachings of the specification.

However, in an earnest effort to advance the prosecution of this case, Applicants have replaced this phrase with the term "comprising", which in accordance with MPEP § 2111.03 is synonymous with "including", "containing" or "characterized by" and means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim. The oligomer O 3003 of Sigma 1990, which matches only 3 bases of the 1823 nucleotide base sequence of SEQ ID NO:12 clearly does not anticipate claims drawn to a polynucleotide comprising this 1823 nucleotide base sequence or a polynucleotide with 97% identity to SEQ ID NO: 12 and which hybridizes under stringent conditions to

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
Filing Date: July 20, 2001
Page 6

the antisense sequence of SEQ ID NO: 12.

Withdrawal of this rejection under 35 U.S.C. § 102(b) is therefore respectfully requested.

III. Rejection of Claims 1 and 2 under 35 U.S.C. § 102(a)

Claims 1 and 2 have been rejected under 35 U.S.C. § 102(a) as being anticipated by GenBank Accession No. AL136666. As acknowledged by the Examiner, this reference published subsequent to the priority date of July 21, 2000 of the instant application. However, the Examiner suggests that the earliest date for prior art purposes with respect to the polypeptide sequence of SEQ ID NO:48 is the filing date of the instant application, July 20, 2001, which is subsequent to the January 2001 publication of GenBank Accession No. AL136666.

As discussed in Section I, *supra*, without conceding to the correctness of the Examiner's position, but rather to expedite the prosecution, Applicants have canceled claim 2 drawn to the subject matter of GenBank Accession No. AL136666, namely SEQ ID NO:48. Accordingly, this rejection based upon the teachings of GenBank Accession No. AL136666 and SEQ ID NO:48 is now moot as the claims are no longer inclusive of this subject matter.

Withdrawal of this rejection under 35 U.S.C. § 102 (a) is

Attorney Docket No.: DEX-0214
Inventors: Macina et al.
Serial No.: 09/909,567
Filing Date: July 20, 2001
Page 7

therefore respectfully requested.

IV. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,

Kathleen A. Tyrrell
Kathleen A. Tyrrell
Registration No. 38,350

Date: October 15, 2003

Licata & Tyrrell P.C.
66 E. Main Street
Marlton, New Jersey 08053

(856) 810-1515

RECEIVED
CENTRAL FAX CENTER

OCT 15 2003

OFFICIAL